

### REMARKS

Applicant has amended claims 1, 8-9, 14-18, and 22-25, and canceled claims 1-8, 10-13, 16 and 21 with respect to the present patent application. Applicant is not conceding in the present patent application that these amended and canceled claims are not patentable over the art cited by the Examiner, as the claim amendments and cancellations are only for facilitating expeditious prosecution of the patent application. Applicant respectfully reserves the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

The Examiner rejected claims 9 and 18-20 under 35 U.S.C. § 102(b) as allegedly being anticipated by Osder et al. (US Patent 5,493,606) hereinafter referred to as "Osder."

The Examiner rejected claims 14, 15, 17 and 22-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osder et al. (US Patent 5,493,606) hereinafter referred to as "Osder."

Applicant respectfully traverses the § 102 and § 103 rejections with the following arguments.

### **35 U.S.C. § 102(b)**

The Examiner rejected claims 9 and 18-20 under 35 U.S.C. § 102(b) as allegedly being anticipated by Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

#### **Claim 9**

Applicant respectfully contends that Osder does not anticipate claim 9, because Osder does not teach each and every feature of claim 9.

As a first example of why Osder does not anticipate claim 9, Osder does not teach the feature: “receiving commands from a telephone caller”.

The Examiner argues that Osder, col. 8, lines 1-7 teaches the preceding feature of claim 9.

In response, Applicant respectfully contends that Osder, col. 8, lines 1-7 teaches receiving “voice messages from a telephone connection”, but does not teach that the voice messages received from the telephone connection are commands. For example, a voice message from a telephone caller may be “hello” which is not a command, “am I properly connected?” which is not a command, “This is John Doe” which is not a command, etc.

To the contrary, Osder, col. 7, lines 67 teaches that commands are received from software, namely through Application Interface Module (AIM) 30.

Further to the contrary, Osder, col. 12, lines 1-6 recites: “With continued reference to FIG. 4, a Network Application 10 uses PEP commands to request the playing of prompts and to supply any dynamic data required by a prompt. A PEP command from a Network Application 10 is intercepted by the agent 16 and passed to PEP 13 along a path 61 for expansion.” The

preceding quote from Osder discloses that the agent 16 receives PEP commands from the Network Application 10, rather than from the user, for playing prompts.

Furthermore, Osder, col. 28, lines 1-7 recites: "The SYSTEM Indexed Prompt Table contains prompt names for the prompts required by PEP 13 for ... providing the voice, beep or tone that notifies a caller to begin recording a message". In other words, Osder teaches the software directing a command to the telephone caller ("notifies a caller to begin recording a message") and not vice versa.

In "Response to Arguments", the Examiner argues: "Osder also discloses a voice interactive system where prompts are played based on communication between a caller and the system through commands. When a caller requests to play a voice message or to access the system, a prompt such as "you have five new messages" or a personal greeting/user name is played (i.e. col. 5 lines 54-56; col. 12 lines 59-61). Without a caller command that is received by an interactive voice response system that plays a voice prompt as in the instant invention and Osder, such a system would not work as an IVR system. To play the prompts in Osder, whether they are for greetings, voice messages, a caller command is needed to select the appropriate prompts in Osder's database."

In response to the preceding argument by the Examiner in "Response to Arguments", Applicant asserts that the Examiner's statement that "such a system would not work as an IVR system" is confusing, because it is Applicant's specification (page 3, lines 2-4) and not Osder that teaches use of an IVR system. Rather, Osder teaches "a prompt management system for playing prompts" (Osder, claim 1).

Furthermore, the Examiner's statement in "Response to Arguments" that "To play the

prompts in Osder, whether they are for greetings, voice messages, a caller command is needed to select the appropriate prompts in Osder's database” is an argument by the Examiner that Osder inherently teaches “receiving commands from a telephone caller”, which is incorrect. Osder, col. 5, lines 51-52 teaches that the Network Application invokes playing of the prompt. Applicant respectfully contends, however, that it is not inherent for the Network Application to receive a command from the user in order to select the prompt to be played. For example, the Network Application could be programmed to automatically play the prompt reciting the number of new messages the user has every time the user initiates a telephone connection with Osder’s SPIN software, without any command being received from the user. As another example, the Network Application could be programmed to automatically play a greeting reciting the user’s name every time the user initiates a telephone connection with Osder’s SPIN software, without any command being received from the user. The Examiner is unable to provide any citations in Osder with accompanying analysis that allegedly demonstrates that Osder explicitly or inherently teaches the feature: “receiving commands from a telephone caller”.

Therefore, Osder does not anticipate claim 9.

As a second example of why Osder does not anticipate claim 9, Osder does not teach the feature: “responsive to said received commands, determining that the voice prompt is needed”.

The Examiner argues that “Osder discloses ... responsive to said received commands, determining that the voice prompt is needed (i.e. "When a Network Application 10 requires that a prompt to be played," col. 7 lines 41-42)”.

In response, Applicant notes that the preceding quote of Osder by the Examiner is

incomplete and hence misleading. The complete quote from Osder, col. 7, lines 41-43 is: "When a Network Application 10 requires that a prompt be played, the Network Application issues a PEP command to the agent 16."

In other words, claim 9 requires that the voice prompt is responsive to the received commands. In contrast, Osder teaches that the PEP command is responsive to a determination that a voice prompt is needed, which does not satisfy the requirement in claim 9 that the voice prompt is responsive to the received commands.

In "Response to Arguments", the Examiner argues: "The examiner investigated the whole instant specification and it recites, "when a voice prompt is needed, the application program provides a metalanguage variable that identifies the function of the voice prompt" in pages 6-7. In Osder, when a "Network Application 10 requires that a prompt to be played (i.e. col. 7 lines 41-42)," in response to a caller command to start the voice interactive system or check the voice message etc, the SPIN application table that assigns the values of the Ids to point to the prompt element sets such as the tables 2-5 containing the pre-recorded prompts in SPINDB as seen in Fig 3 is accessed. As has been pointed out in the examiner's answer mailed on 5/16/2006, the SPIN Id values (UV 10AE, UV 10SP etc in table 1) are the entry points to the pre-recorded prompt elements (Osder, col. 28 lines 30-40) "for selectively playing the prompts either in American English, Spanish ...etc (col. 8 lines 32-36)" when the voice prompts are needed to be played."

In response to the preceding argument by the Examiner in "Response to Arguments", Applicant asserts that the Examiner's statement that Applicant's specification recites "when a voice prompt is needed, the application program provides a metalanguage variable that identifies the function of the voice prompt" is irrelevant to the preceding feature of claim 9. The preceding

feature of claim 9 recites “responsive to said received commands, determining that the voice prompt is needed”, which is not addressed in the preceding argument by the Examiner in “Response to Arguments”

Therefore, Osder does not anticipate claim 9.

As a third example of why Osder does not anticipate claim 9, Osder does not teach the feature:

“identifying a first database record that includes a digitally encoded voice prompt consisting of a first bit pattern that consists of a first sequence of bits, wherein the bits of the first sequence of bits are stored contiguously in the identified first database record, and wherein said identifying the first database record is implemented through use of the first value which selects the first database record and specifies the first bit pattern;

performing a first process that generates a first complete message from the identified first database record and speaks the generated first complete message to the telephone caller, said performing the first process consisting of the steps of:

reading the identified first database record;

passing the first bit pattern from the first database record that had been read to an audio apparatus;

performing, by the audio apparatus, a digital-to-analog conversion of the first bit pattern that had been passed to the audio apparatus;

speaking, by the audio apparatus, the first complete message to the telephone caller, said first complete message consisting of the digital-to-analog converted first bit pattern.”

As indicated in the decision of the Board of Appeals and Interferences (page 4, line 22 - page 5, line 3) on February 21, 2007, Osder’s voice prompt that is spoken at runtime is

assembled by inserting dynamic data (e.g., from Table 5 of Osder) into a template (e.g., from Table 3 of Osder) having static elements and missing portions, wherein the dynamic elements are inserted into the missing portions of the template to generate the final assembled voice prompt. See also, Osder, col. 1, lines 48-57 which recites: "A prompt is composed of and defined by a sequence of static and dynamic elements. A static element denotes a fixed phrase, whereas a dynamic element provides a location in the prompt for variable data to be provided by the Network Application at run time. For example, in the prompt "you have <number> new messages", the phrases "you have" and "new messages" are static elements whereas <number> is a dynamic element to be provided by the Network Application in accordance with the conditions at run time."

Osder does not teach omission of the preceding "assembling step" of assembling the runtime voice prompt by inserting the dynamic data into the template having the static elements and the missing data. Therefore, by being required to perform said "assembling step" which is not a step in the claimed first process, Osder does not teach performing the claimed first process consisting of the steps of: the recited step of reading, the recited step of passing the first bit pattern, the recited step of performing the a digital-to-analog conversion, and the recited step of speaking, the first complete message to the telephone caller. Accordingly, Osder does not anticipate claim 9.

Furthermore, by being required to perform said "assembling step", it is logically impossible for Osder to teach that the content of the first complete spoken message at runtime consists of the digital-to-analog converted first bit pattern existing in the first database record, as recited in claim 9.

In other words, Osder's voice prompt that is spoken at runtime is generated by the "assembling step" from two distinct bit patterns located in different database records, namely first bit pattern consisting of a static element located in one portion of a database and a second bit pattern consisting of a dynamic element located in another portion of the database. The Examiner has acknowledged that the static and dynamic elements are stored in separate tables, namely Tables 3 and 5, respectively, and therefore do not collectively constitute a bit pattern that is stored in the first database record.

In "Response to Arguments", the Examiner argues: "although the applicant uses the exemplary prompt "you have five new messages" found in Osder for his argument, it is noted that the prompt is only one example given in Osder's voice response system. Even in this exemplary prompt, "you," for example, can be considered as a first bit pattern existing in the first database record where each bits of "you" is stored contiguously prior to the conversion. The prompt, "you" played first (digital-to-analog conversion) is stored as contiguous bits."

In response to the preceding argument by the Examiner in "Response to Arguments", Applicant acknowledges that the bits for "you" are stored contiguously. However, the preceding feature of claim 9 recites "identifying a first database record that includes a digitally encoded voice prompt consisting of a first bit pattern that consists of a first sequence of bits, wherein the bits of the first sequence of bits are stored contiguously in the identified first database record". The phrase "you have five new messages" is the digitally encoded voice prompt consisting of a first bit pattern and the bits of the word "you" is not the bit pattern of the prompt "you have five new messages". Therefore, the preceding argument by the Examiner is not persuasive.

In "Response to Arguments", the Examiner further argues: "is noted that Osder states that



every static and dynamic element of a SPIN application is recorded in the cache element table 80 (col. 10, lines 6-9; see, fig 5A) to play the whole prompt such as "you have five new messages".

In response to the preceding argument by the Examiner in "Response to Arguments", Applicant notes that the Examiner's statement that "every static and dynamic element of a SPIN application is recorded in the cache element table 80 ... to play the whole prompt" is correct but not relevant to the preceding feature of claim 9. Osder does not teach that the bits of the static and dynamic elements of the first complete spoken message are stored together contiguously as sequence of bits in the cache element table 80 of FIG. 5A. For example Osder, FIG. 5A explicitly depicts the static sub-components "YOU HAVE" and "NEW MESSAGES" as being stored non-contiguously with respect to each other and does not depict the dynamic component (e.g., "FIVE") as being stored contiguously with respect to the static components of "YOU HAVE" and "NEW MESSAGES" in the required contiguous sequence of "YOU HAVE" "FIVE" "NEW MESSAGES".

Moreover, using the Examiner's example of "you have five new messages", Osder does not teach the step of "speaking, by the audio apparatus, a first complete message to the telephone caller, said first complete message consisting of the digital-to-analog converted first bit pattern". In this example, the first complete message spoken to the telephone caller ("you have five new messages") is not the result of a digital-to-analog conversion of a first bit pattern such that the first bit pattern consists of a contiguous sequence of bits, wherein the bits of the first sequence of bits are stored contiguously in the first database record prior to the digital-to-analog conversion. The spoken complete message is the result of converting three distinct bit patterns ("you have", "five", and "new messages") which do not collectively constitute a sequence of bits stored

contiguously in a first database record prior to the digital-to-analog conversion. Osder teaches that the bits of the bit pattern “you have” is stored contiguously. Osder teaches that the bits of the bit pattern “five” is stored contiguously. Osder teaches that the bits of the bit pattern “new messages” is stored contiguously. However, Osder does not teach that the bits of the bit pattern “you have five new messages” is stored contiguously in a first database record prior to the digital-to-analog conversion, as required by claim 9.

Therefore, Osder does not teach the preceding feature of claim 9.

Based on the preceding arguments, Applicant respectfully maintains that Osder does not anticipate claim 9, and that claim 9 is in condition for allowance.

#### Claim 18

Since claim 18 depends from claim 9 which Applicant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Applicant maintains that claim 18 is likewise not anticipated by Osder under 35 U.S.C. §102(b).

In addition with respect to claim 18, Osder does not teach the feature:

“identifying a second database record that includes a digitally encoded voice prompt consisting of a second bit pattern that consists of a second sequence of bits wherein the bits of the second sequence of bits are stored contiguously in the identified second database record, and wherein the second bit pattern differs from the first bit pattern, and wherein said identifying the second database record is implemented through use of the second value which selects the second database record and specifies the second bit pattern;

performing a second process that generates a second complete message from the identified second database record and speaks the generated second complete message to the

telephone caller, said performing the second process consisting of the steps of:

- reading the second database record;
- passing the second bit pattern from the second database record that had been read to the audio apparatus;
- performing, by the audio apparatus, a digital-to-analog conversion of the second bit pattern that had been passed to the audio apparatus; and
- speaking, by the audio apparatus, a second complete message to the telephone caller, said second complete message consisting of the digital-to-analog converted second bit pattern.”

As indicated in the decision of the Board of Appeals and Interferences (page 4, line 22 - page 5, line 3) on February 21, 2007, Osder’s voice prompt that is spoken at runtime is assembled by inserting dynamic data (e.g., from Table 5 of Osder) into a template (e.g., from Table 3 of Osder) having static elements and missing portions, wherein the dynamic elements are inserted into the missing portions of the template to generate the final assembled voice prompt. See also, Osder, col. 1, lines 48-57 which recites: “A prompt is composed of and defined by a sequence of static and dynamic elements. A static element denotes a fixed phrase, whereas a dynamic element provides a location in the prompt for variable data to be provided by the Network Application at run time. For example, in the prompt "you have <number> new messages", the phrases "you have" and "new messages" are static elements whereas <number> is a dynamic element to be provided by the Network Application in accordance with the conditions at run time.”

Osder does not teach omission of the preceding “assembling step” of assembling the runtime voice prompt by inserting the dynamic data into the template having the static elements

and the missing data. Therefore, by being required to perform said “assembling step” which is not a step in the claimed second process, Osder does not teach performing the claimed second process consisting of the steps of: the recited step of reading, the recited step of passing the second bit pattern, the recited step of performing the a digital-to-analog conversion, and the recited step of speaking, the second complete message to the telephone caller. Accordingly, Osder does not anticipate claim 18.

Furthermore, by being required to perform said “assembling step”, it is logically impossible for Osder to teach that the content of the second complete spoken message at runtime consists of the digital-to-analog converted second bit pattern existing in the second database record, as recited in claim 18.

In other words, Osder’s voice prompt that is spoken at runtime is generated by the “assembling step” from two distinct bit patterns located in different database records, namely second bit pattern consisting of a static element located in one portion of a database and a second bit pattern consisting of a dynamic element located in another portion of the database. The Examiner has acknowledged that the static and dynamic elements are stored in separate tables, namely Tables 3 and 5, respectively, and therefore do not collectively constitute a bit pattern that is stored in the second database record.

In “Response to Arguments”, the Examiner argues (with respect to claim 9 but states on page 14, lines 13-14 that this argument also applies to claim 18): “although the applicant uses the exemplary prompt “you have five new messages” found in Osder for his argument, it is noted that the prompt is only one example given in Osder’s voice response system. Even in this exemplary prompt, “you,” for example, can be considered as a first bit pattern existing in the first database

record where each bits of "you" is stored contiguously prior to the conversion. The prompt, "you" played first (digital-to-analog conversion) is stored as contiguous bits."

In response to the preceding argument by the Examiner in "Response to Arguments", Applicant acknowledges that the bits for "you" are stored contiguously. However, the preceding feature of claim 18 recites "identifying a second database record that includes a digitally encoded voice prompt consisting of a second bit pattern that consists of a second sequence of bits wherein the bits of the second sequence of bits are stored contiguously in the identified second database record". The phrase "you have five new messages" is the digitally encoded voice prompt consisting of a second bit pattern and the bits of the word "you" is not the bit pattern of the prompt "you have five new messages". Therefore, the preceding argument by the Examiner is not persuasive.

In "Response to Arguments", the Examiner further argues: "is noted that Osder states that every static and dynamic element of a SPIN application is recorded in the cache element table 80 (col. 10, lines 6-9; see, fig 5A) to play the whole prompt such as "you have five new messages"".

In response to the preceding argument by the Examiner in "Response to Arguments", Applicant notes that the Examiner's statement that "every static and dynamic element of a SPIN application is recorded in the cache element table 80 ... to play the whole prompt" is correct but not relevant to the preceding feature of claim 18. Osder does not teach that the bits of the static and dynamic elements of the second complete spoken message are stored together contiguously as sequence of bits in the cache element table 80 of FIG. 5A. For example Osder, FIG. 5A explicitly depicts the static sub-components "YOU HAVE" and "NEW MESSAGES" as being stored non-contiguously with respect to each other and does not depict the dynamic component

(e.g., “FIVE”) as being stored contiguously with respect to the static components of “YOU HAVE” and “NEW MESSAGES” in the required contiguous sequence of “YOU HAVE” “FIVE” “NEW MESSAGES”.

Moreover, using the Examiner’s example of “you have five new messages”, Osder does not teach the step of “speaking, by the audio apparatus, a second complete message to the telephone caller, said second complete message consisting of the digital-to-analog converted second bit pattern”. In this example, the second complete message spoken to the telephone caller (“you have five new messages”) is not the result of a digital-to-analog conversion of a second bit pattern such that the second bit pattern consists of a contiguous sequence of bits, wherein the bits of the second sequence of bits are stored contiguously in the second database record prior to the digital-to-analog conversion. The spoken complete message is the result of converting three distinct bit patterns (“you have”, “five”, and “new messages”) which do not collectively constitute a sequence of bits stored contiguously in a second database record prior to the digital-to-analog conversion. Osder teaches that the bits of the bit pattern “you have” is stored contiguously. Osder teaches that the bits of the bit pattern “five” is stored contiguously. Osder teaches that the bits of the bit pattern “new messages” is stored contiguously. However, Osder does not teach that the bits of the bit pattern “you have five new messages” is stored contiguously in a second database record prior to the digital-to-analog conversion, as required by claim 18.

Therefore, Osder does not teach the preceding feature of claim 18.

#### Claim 19

Since claim 19 depends from claim 9 which Applicant has argued *supra* to not be

anticipated by Osder under 35 U.S.C. §102(b), Applicant maintains that claim 19 is likewise not anticipated by Osder under 35 U.S.C. §102(b)..

In addition with respect to claim 18, Osder does not teach the feature: “wherein said assigning the second value and said replacing the first value with the second value are performed by an interactive voice response (IVR) system administrator”.

The Examiner argues that Osder, col. 3, line 64 - col. 4, line 5 teach the preceding feature of claim 19.

In response, Applicant respectfully contends that Osder, col. 3, line 64 - col. 4, line 5 teach that the user can create and/or modify element of voice prompts. However, the preceding feature of claim 19 recites that an IVR system administrator replaces the first value with the second value, and Osder does not teach that the user is or can be an IVR system administrator.

In the Examiner comments in “Response to Arguments” for claim 20, the Examiner argues that the user is an IVR system administrator. More specifically, the Examiner argues: “Osder discloses the SPIN Administration Facility 40 (i.e. col. 16 lines 43-45). The person who uses the facility is a system administrator. Second, an administrator is a user who can manage an operation of a system or a specific project. Certainly a user can be a system administrator of his/her own system or program”.

In response, Applicants respectfully contend that the words “interactive voice response (IVR)” in the phrase “interactive voice response (IVR) system administrator” clarifies that the claimed system administrator is one who manages the IVR system and not a user who manages the user’s own system or program. Accordingly, the preceding argument by the Examiner is not persuasive.

Therefore, Osder does not teach the preceding feature of claim 19.

#### Claim 20

Since claim 20 depends from claim 9 which Applicant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Applicant maintains that claim 20 is likewise not anticipated by Osder under 35 U.S.C. §102(b).

In addition with respect to claim 20, Osder does not teach the feature: “wherein said replacing the first value with the second value by the IVR system administrator does not comprises using special IVR programming skill to replace the first value with the second value”.

The Examiner argues: “Osder further discloses: wherein said replacing the first value with the second value by the IVR system administrator does not comprises using special IVR programming skill to replace the first value with the second value (i.e. col. 3 lines 64- col. 4 lines 1-5, 33-37).”

In response, Applicant respectfully contends that the preceding citations to Osder do not teach that the IVR system administrator does not use special IVR programming skill to replace the first value with the second value. Therefore, the Examiner’s argument is not persuasive.

In “Response to Arguments”, the Examiner argues that the user is an IVR system administrator and therefore would not use special IVR programming skill to replace the first value with the second value. More specifically, the Examiner argues: “Osder discloses the SPIN Administration Facility 40 (i.e. col. 16 lines 43-45). The person who uses the facility is a system administrator. Second, an administrator is a user who can manage an operation of a system or a specific project. Certainly a user can be a system administrator of his/her own system or



program”.

In response, Applicants respectfully contend that the words “interactive voice response (IVR)” in the phrase “interactive voice response (IVR) system administrator” clarifies that the claimed system administrator is one who manages the IVR system and not a user who manages the user’s own system or program. Accordingly, the preceding argument by the Examiner is not persuasive.

Therefore, Osder does not teach the preceding feature of claim 20.

**35 U.S.C. § 103(a)**

The Examiner rejected claims 14, 15, 17 and 22-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osder et al. (US Patent 5,493,606) hereinafter referred to as "Osder."

In addition with respect to claims 14-15, the decision of the Board of Appeals and Interferences (page 7, line 24 - page 8, line 7) on February 21, 2007 recites: "We will sustain the Examiner's rejection of claims 3-8 and 11-16. At the outset, we note that specifying the various attributes of voice prompts in these claims merely describes the content of the data stored in the voice prompt database. Because this data content does not further limit the claimed invention either functionally or structurally, it essentially constitutes non-functional descriptive material. Such non-functional descriptive material, however, does not patentably distinguish over prior art that otherwise renders the claims unpatentable. *See In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)."

In light of the preceding analysis by the Board of Appeals and Interferences, Applicants have restructured the language of claims 14-15 in a manner that the recited attributes of the voice prompts do not merely describe the content of the data stored in the voice prompt database, but actually recite the active method steps of speaking the first message. The language of claim 17 has been similarly restructured, as is the language of claims 22-25. Thus, the language of claims 14-15, 17, and 22-25 comprises functional material in the form of active method steps.

Applicant's analysis *infra* with respect to claims 14-15, 17, and 22-25 will make use of the following rules of law: A rejection of a claim on grounds of obviousness requires that all features of the claim are ***known*** in the prior art.

An attempt to show that it is obvious to combine elements to disclose the claimed invention starts with elements that are known in the prior art and then seeks to demonstrate that it is obvious to combine the elements. *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) ("When it first established the requirement of demonstrating a teaching, suggestion, or motivation to combine **known elements** in order to show that the combination is obvious, the Court of Customs and Patent Appeals captured a helpful insight. See *Application of Bergel*, 292 F. 2d 955, 956-957 (1961)") (emphasis added).

Insight as to why all elements of a claim must be known to reject the claim on grounds of obviousness is provided in *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (reversing the Board's rejection of a claim based on alleged inherency under 35 U.S.C. 103 of a method to curb appetite, and stating: "[t]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. **Obviousness cannot be predicated on what is unknown**")." (emphasis added)

In other words, demonstrating obviousness for modifying a relied-upon reference by subject matter not disclosed in the relied-upon reference comprises a first step and a second step. The first step is to provide legally acceptable evidence that the subject matter not disclosed in the relied-upon reference is known in the prior art. The second step is to provide analysis demonstrating that it is obvious to modify the relied-upon reference by incorporating into the relied-upon reference the subject matter that is known in the prior art but is not disclosed in the relied-upon reference.

Applicants will present arguments *infra* that the Examiner has repeatedly and consistently attempted to demonstrate obviousness by modifying the relied-upon reference of Osder by

skipping the first step and arguing only the second step, which is legally impermissible under *KSR Int'l Co. v. Teleflex Inc.* More specifically, Applicant will present arguments *infra* demonstrating that the Examiner's arguments with respect to various claims of claims 14-15, 17, and 22-25 has repeatedly rejected claims on grounds of obviousness without demonstrating that all elements of the claim are known in the prior art.

Applicant reiterates the following explanation for the preceding rule in *KSR Int'l Co. v. Teleflex Inc.* which limits the obviousness of modifying a relied-upon reference to incorporation of only **known** subject matter", namely the explanation that "Obviousness cannot be predicated on what is unknown" as recited in *In re Shetty*.

#### Claim 14

Since claim 14 depend from claim 9, which Applicant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Applicants maintain that claim 14 is not unpatentable over Osder under 35 U.S.C. §103(a).

In addition with respect to claim 14, Applicant respectfully contends that Osder does not disclose the feature: "wherein the voice prompt pertaining to the first bit pattern in the first database record consists of music, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said music".

The Examiner argues that "Per claim 14: ... Osder does not explicitly teach pertaining to the first bit pattern in the first database record consists of music wherein said speaking the first

complete message comprises speaking the first complete message consisting of the digital-to-analog converted first bit pattern as said music. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include music voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 14. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is **unknown** in the prior art.

The Examiner has not cited any prior art allegedly disclosing that it is known in the prior art to have a voice prompt consisting of music. Moreover, the Examiner has not cited any prior art allegedly disclosing that a preference for a voice prompt consisting of music is known in the prior art. Thus, the Examiner is arguing that it is obvious to modify Osder by including the **unknown** feature of using a voice prompt consisting of music, which is not legally permitted under *KSR Int’l Co. v. Teleflex Inc.* As *In re Shetty* states “Obviousness cannot be predicated on what is unknown”. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 14.

Accordingly, claim 14 is not unpatentable under 35 U.S.C. §103(a) over Osder.

### Claim 15

Since claim 15 depend from claim 9, which Applicant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Applicants maintain that claim 15 is not unpatentable over Osder under 35 U.S.C. §103(a).

### Claim 17

Since claim 17 depend from claim 9, which Applicant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Applicants maintain that claim 17 is not unpatentable over Osder under 35 U.S.C. §103(a).

In addition with respect to claim 14, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of a sequence of beeps, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said sequence of beeps”.

The Examiner argues that “Per claim 17: ... Osder does not explicitly teach pertaining to the first bit pattern in the first database record consists of a sequence of beeps wherein said speaking the first complete message comprises speaking the first complete message consisting of the digital-to-analog converted first bit pattern as said a sequence of beeps. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including beeps as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for

different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 17. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is **unknown** in the prior art.

The Examiner has not cited any prior art allegedly disclosing that it is known in the prior art to have a voice prompt consisting of a sequence of beeps. Moreover, the Examiner has not cited any prior art allegedly disclosing that a preference for a voice prompt consisting of a sequence of beeps is known in the prior art. Thus, the Examiner is arguing that it is obvious to modify Osder by including the **unknown** feature of using a voice prompt consisting of a sequence of beeps, which is not legally permitted under *KSR Int'l Co. v. Teleflex Inc.* As *In re Shetty* states “Obviousness cannot be predicated on what is unknown”. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 17.

Accordingly, claim 17 is not unpatentable under 35 U.S.C. §103(a) over Osder.

#### Claim 22

Since claim 22 depends from claim 9, which Applicant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Applicants maintain that claim 22 is not unpatentable over Osder under 35 U.S.C. §103(a).

In addition with respect to claim 22, Applicant respectfully contends that Osder does not disclose the feature:

“wherein the voice prompt pertaining to the first bit pattern in the first database record is spoken by a first speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a second speaker; wherein said speaking the first message comprises speaking by the first speaker the first message consisting of the digital-to-analog converted first bit pattern; and wherein said speaking the second message comprises speaking by the second speaker the second message consisting of the digital-to-analog converted second bit pattern ” in combination with

“replacing the first value of the variable in the assignment table with the assigned second value of the variable; identifying a second database record that includes a digitally encoded voice prompt consisting of a second bit pattern that consists of a second sequence of bits wherein the bits of the second sequence of bits are stored contiguously in the identified second database record, and wherein the second bit pattern differs from the first bit pattern, and wherein said identifying the second database record is implemented through use of the second value which selects the second database record and specifies the second bit pattern”.

The Examiner argues that “Osder does not explicitly teach that the voice prompt pertaining to the first bit pattern in the first database record is spoken by a first speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a second speaker; wherein said speaking the first complete message comprises speaking by the first speaker the first complete message ... wherein said speaking the second complete message comprises speaking by the second speaker the second complete message consisting of the digital-to-analog converted second bit pattern. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different voice prompts spoken by different speakers as callers may have different preferences



and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different purposes.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 22. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is **unknown** in the prior art.

The Examiner has not cited any prior art allegedly disclosing a first speaker and a second speaker speaking a voice pattern pertaining to a first bit pattern and a second bit pattern, respectively, wherein the second bit pattern differs from the first bit pattern, and second value that replaces the first value is used to specify the second bit pattern. Moreover, the Examiner has not cited any prior art allegedly disclosing that a preference for the aforementioned first and second messages is known in the prior art. Thus, the Examiner is arguing that it is obvious to modify Osder by including the preceding unknown feature, which is not legally permitted under *KSR Int'l Co. v. Teleflex Inc.* As *In re Shetty* states “Obviousness cannot be predicated on what is unknown”. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 22.

Accordingly, claim 22 is not unpatentable under 35 U.S.C. §103(a) over Osder.

### Claim 23

Since claim 23 depends from claim 9, which Applicant has argued *supra* to not be

anticipated by Osder under 35 U.S.C. §102(b), Applicants maintain that claim 23 is not unpatentable over Osder under 35 U.S.C. §103(a).

#### Claim 24

Since claim 24 depend from claim 9, which Applicant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Applicants maintain that claim 24 is not unpatentable over Osder under 35 U.S.C. §103(a).

In addition with respect to claim 24, Applicant respectfully contends that Osder does not disclose the feature: “As to claim 24, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record has a first level of formality; wherein the voice prompt pertaining to the second bit pattern in the second database record has a second level of formality that differs from the first level of formality; wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern having the first level of formality; and wherein said speaking the second message comprises speaking the second message consisting of the digital-to-analog converted second bit pattern having the second level of formality”.

The Examiner argues that “Osder does not explicitly teach the voice prompt pertaining to the first bit pattern in the first database record has a first level of formality; wherein the voice prompt pertaining to the second bit pattern in the second database record has a second level of formality that differs from the first level of formality; wherein said speaking the first complete message ...second complete message consisting of the digital-to-analog converted second bit

pattern having the second level of formality. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different level of formality of voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 24. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is **unknown** in the prior art.

The Examiner has not cited any prior art allegedly disclosing that it is known in the prior art to have different voice prompts for different levels of formality. Moreover, the Examiner has not cited any prior art allegedly disclosing that a preference for different voice prompts for different levels of formality is known in the prior art. Thus, the Examiner is arguing that it is obvious to modify Osder by including the **unknown** feature of using a voice prompt consisting of a sequence of beeps, which is not legally permitted under *KSR Int’l Co. v. Teleflex Inc.* As *In re Shetty* states “Obviousness cannot be predicated on what is unknown”. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 24.

Accordingly, claim 24 is not unpatentable under 35 U.S.C. §103(a) over Osder.

### Claim 25

Since claim 25 depend from claim 9, which Applicant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Applicants maintain that claim 25 is not unpatentable over Osder under 35 U.S.C. §103(a).

In addition with respect to claim 24, Applicant respectfully contends that Osder does not disclose the feature:

“wherein the voice prompt pertaining to the first bit pattern in the first database record is spoken by a speaker in a first wording and conveys a meaning; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by the speaker in a second wording that differs from the first wording and conveys said meaning; wherein said speaking the first message comprises speaking by the speaker the first message consisting of the digital-to-analog converted first bit pattern in the first wording that conveys said meaning; and wherein said speaking the second message comprises speaking by the speaker the second message consisting of the digital-to-analog converted second bit pattern in the second wording that conveys said meaning” in combination with

“replacing the first value of the variable in the assignment table with the assigned second value of the variable; identifying a second database record that includes a digitally encoded voice prompt consisting of a second bit pattern that consists of a second sequence of bits wherein the bits of the second sequence of bits are stored contiguously in the identified second database record, and wherein the second bit pattern differs from the first bit pattern, and wherein said identifying the second database record is implemented through use of the second value which selects the second database record and specifies the second bit pattern”.

The Examiner argues that “Osder does not explicitly teach that the voice prompt pertaining...spoken by a speaker in a first wording and coveys a meaning...second wording that differs from the first wording and coveys said meaning...in the first wording that conveys said

meaning...second bit pattern in the second wording that conveys said meaning. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including a dialect as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 25. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is **unknown** in the prior art. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 25.

The Examiner has not cited any prior art allegedly disclosing that it is known in the prior art to have voice prompts pertaining to different bit patterns (i.e., a second bit pattern differing from a first bit pattern) spoken by a same speaker and conveying a same meanings wherein the second the value that replaces the first value is used to specify the second bit pattern. Moreover, the Examiner has not cited any prior art allegedly disclosing that a preference for different voice prompts spoken by a same speaker and conveying a same meaning, wherein the second bit pattern differs from a first bit pattern, and wherein the second the value that replaces the first value is used to specify the second bit pattern. Thus, the Examiner is arguing that it is obvious to

modify Osder by including the preceding *unknown* feature, which is not legally permitted under *KSR Int'l Co. v. Teleflex Inc.* As *In re Shetty* states “Obviousness cannot be predicated on what is unknown”. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 25.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 25, because of lack of enablement. Applicant asserts that a rejection of a claim on grounds of obviousness though use of a prior art reference or a combination of prior art references requires that the prior art teach enablement for combining subject matter in the prior art references to make and use the claimed invention. In particular, *In re Kumar*, 76 USPQ2d 1048 (Fed. Cir. 2005) is the current controlling case law regarding the requirement that the prior art must enable claimed subject matter. In *In re Kumar*, the Federal Circuit states: “Although published subject matter is “prior art” for all that it discloses, in order to render an invention unpatentable for obviousness, the prior art must **enable** a person of ordinary skill to make and use the invention.... To render **a later invention** unpatentable for obviousness, the prior art must **enable** a person of ordinary skill in the field to make and use the **later invention**.” (emphasis added), *Kumar*, 76 USPQ2d at 1052, 1053.

As to enablement, Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teach how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are synthesized with different wording having the same meaning. Therefore, there is a lack of

enablement for including dynamic elements within a template of static elements when the static and dynamic elements are synthesized with different wording having the same meaning, and the enablement required of the cited prior art reference as set forth in *In re Kumar* (as discussed *supra*) is not satisfied. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 25.

Accordingly, claim 25 is not unpatentable under 35 U.S.C. §103(a) over Osder.

### CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457 (IBM).

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